

ESTTA Tracking number: **ESTTA297414**

Filing date: **07/27/2009**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Stephen Slesinger, Inc.
Granted to Date of previous extension	07/29/2009
Address	1111 N. Westshore Boulevard Suite 604 Tampa, FL 33607 UNITED STATES
Attorney information	Andrew D. Skale Mintz, Levin, Cohn, Ferris, Glovsky and Popeo, P.C. 3580 Carmel Mountain Road Suite 300 San Diego, CA 92130 UNITED STATES adskale@mintz.com, snweller@mintz.com Phone:(858) 314-1506

### Applicant Information

Application No	77189502	Publication date	03/31/2009
Opposition Filing Date	07/27/2009	Opposition Period Ends	07/29/2009
Applicant	Disney Enterprises, Inc. 500 South Buena Vista Street Burbank, CA 91521 UNITED STATES		

### Goods/Services Affected by Opposition

Class 016.

All goods and services in the class are opposed, namely: Address books; almanacs; appliques in the form of decals; appointment books; art prints; arts and craft paint kits; autograph books; baby books; ball point pens; baseball cards; binders; bookends; bookmarks; books featuring games; books featuring stories for children; series of fiction books; bumper stickers; calendars; cartoon strips; Christmas cards; chalk; children's activity books; coasters made of paper; coin albums; coloring books; color pencils; comic books; comic strips; coupon books; decals; decorative paper centerpieces; diaries; disposable diapers for babies; drawing rulers; envelopes; erasers; felt pens; flash cards; gift cards; gift wrapping paper; globes; greeting cards; guest books; magazines featuring stories, games and activities for children; maps; memo pads; modeling clay; newsletters featuring stories, games and activities for children; newspapers; note paper; notebooks; notebook paper; paintings; paper flags; paper party favors; paper cake decorations; paper party decorations; paper napkins; paper party bags; paper weights; paper gift wrap bows; paper pennants; paper place mats; paper table cloths; pen or pencil holders; pencils; pencil sharpeners; pen and pencil cases and boxes; pens; periodicals featuring stories, games and activities for children; photograph albums; photographs; photo-engravings; pictorial prints; picture books; portraits; postcards; posters; printed awards; printed certificates; printed invitations; printed menus; recipe books; rubber stamps; score cards; stamp albums; stationery; staplers; stickers; trading cards; ungraduated rulers; writing paper;

writing implements
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## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Lack of Ownership

## Marks Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WINNIE-THE POOH CHRISTOPHER ROBIN		
Goods/Services	Wearing apparel for men, women, and children # namely, nightgowns, nightshirts, and pajamas, underwear made of knitted, netted and textile materials, shoes and slippers made of leather, fabric, rubber and/or combinations thereof; women#s and children#s coats, cloaks, and suits; and men#s and boys# suits, including coats, vests, and trousers and overcoats; sweaters, hats, caps for men, women and children, and bathing suits.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WINNIE-THE-POOH CHRISTOPHER ROBIN		
Goods/Services	Chinaware and pottery, bric-a-brac, and reflectors, globes and shades of china and porcelain.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WINNIE-THE-POOH CHRISTOPHER ROBIN		
Goods/Services	Games # namely, card games, board games, educational card games, puzzles, parlor board games; toys # namely figure toys, dolls, doll houses, mechanical toys, construction toys and roller toys; and sporting goods #namely baseball bats, gloves, masks, leg guards, balls; tennis rackets, nets, balls; footballs, football masks, leg guards, shin guards; basketballs and nets; lacrosse clubs, balls, body guards, masks; golf balls, clubs, golf bags; skates, both roller and ice.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WINNIE-THE-POOH CHRISTOPHER ROBIN		
Goods/Services	Candle sticks, lamp shades not made of glass, but of such materials as silk, linen, paper, wood and metal; and lamp bases.		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	WINNIE-THE-POOH CHRISTOPHER ROBIN		

Goods/Services	Flat and hollow silverware used for table and toilet purposes.
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Related Proceedings	Opposition Nos. 91179064 - 91182358 - 91183644 - 91186026 - 91187261 - 91188860 Cancellation No. 92046853
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Attachments	Notice of Opposition - CLASSIC POOH No. 77189502.pdf ( 10 pages )(419228 bytes )
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### **Certificate of Service**

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Andrew D. Skale/
Name	Andrew D. Skale
Date	07/27/2009

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Application Ser. No. 77/189502 for the mark: CLASSIC POOH (& Design)  
Published in the *Official Gazette* on March 31, 2009

STEPHEN SLESINGER, INC.

Opposer,

v.

DISNEY ENTERPRISES, INC.

Applicant.

Opposition No. \_\_\_\_\_

Trademark Assistance Center  
Madison East, Concourse Level Room C 55  
600 Dulany Street  
Alexandria, Virginia 22314

**NOTICE OF OPPOSITION**

Stephen Slesinger, Inc. ("Opposer"), a New York corporation, located and doing business at 1111 N. Westshore Boulevard, Suite 604, Tampa, Florida 33607, believes that it will be damaged by registration of U.S. Application Serial No. 77/189502 for the mark CLASSIC POOH (& Design); and hereby opposes the same. The goods for the marks are outlined in Schedule A, attached hereto.

Pursuant to 15 U.S.C. §§ 1051, 1052, 1063 and 1125 of the Lanham Act, and 37 C.F.R. §§ 2.101 and 2.104, and predicated upon the following grounds, Opposer alleges the following:

### **FACTUAL BACKGROUND**

1. Upon information and belief, Disney Enterprises, Inc. (“Applicant”) is a Delaware corporation with an address at 500 South Buena Vista Street, Burbank, California 91521.

Applicant seeks to register the mark CLASSICH POOH (& Design) (the “Mark”) for various goods identified in Schedule A, pursuant to an intent-to-use application filed on May 24, 2007.

2. In the 1920s, author A.A. Milne wrote a collection of stories and verses which appeared in periodicals and in volume book form (“The Winnie-the-Pooh Stories”). Several noted American and British artists decorated those stories and verses, solely for various magazine and book publishers, with black and white ink sketches in a style that was popular during those days. Beginning in 1930, Milne assigned certain sole and exclusive rights to Stephen Slesinger, Inc.’s (“Opposer”) predecessor, Mr. Stephen Slesinger, including the right to create new drawings and to commercialize goods and services utilizing the names, drawings, chapter headings and other material from The Winnie-the-Pooh Stories, as well as the right to apply for trademarks in Slesinger’s name, along with other sole and exclusive rights, *inter alia*, performing and reproduction rights, whether then known or developed in the future.

3. Beginning in 1930 and continuing thereafter, Opposer created new drawings, registered the marks and developed the characters into at least two distinctive brands which Opposer utilized consistently in interstate commerce and various forms of media. Beginning in 1961 and again in 1983, Opposer licensed certain rights to Applicant. Applicant, since 1961, has been and is Opposer’s licensee with respect to the Mark (and other marks related to The Winnie-the-Pooh Stories), for certain authorized uses.

4. Through the acquisition of those rights, Opposer initiated and has been responsible for the development and popularization of the characters from The Winnie-the-Pooh

Stories in the United States for more than 75 years. Opposer secured trademark rights in marks related to the characters of The Winnie-the-Pooh Stories for 30 years prior to licensing certain of those rights to Applicant. For example, between January 1931 and December 1933, Opposer filed numerous trademark applications, including for the mark WINNIE-THE-POOH CHRISTOPHER ROBIN for various goods as outlined in Schedule B, including the broad categories of clothing and apparel, china and pottery, games and toys, candlesticks and lampshades, and silverware. Each of these applications matured to registration (although those registrations may have not been renewed, Opposer maintains its common law rights in that marks).

5. Notwithstanding that Applicant has been Opposer's licensee since the 1960s, prior to the commencement of legal disputes between the parties, Opposer is not aware of any instance in which Applicant has contested Opposer's ownership rights to the marks related to the characters of The Winnie-the-Pooh Stories. It has only been in reaction to these legal disputes between the parties that Applicant has unlawfully attempted to secure ownership rights in these marks, by filing a flurry of trademark applications. Upon information and belief, Applicant is now attempting to secure ownership rights in these marks because of those legal disputes.

6. Opposer has never consented to Applicant applying for or securing registration of the Mark in Applicant's name.

7. On November 30, 2006, Opposer filed a Petition for Cancellation against Applicant before this Board, claiming a likelihood of confusion and fraud for a number of marks that Applicant had wrongfully registered in its name. That proceeding is currently suspended pending the disposition of a civil action between the parties, Case No. CV-02-08508 FMC, pending before the U.S. District Court for the Central District of California.

8. On August 22, 2007, February 8, 2008, April 18, 2008, August 27, 2008, October 31, 2008 and February 17, 2009 Opposer filed six Oppositions against Applicant before this Board, claiming, among other things, fraud, lack of ownership, and likelihood of confusion, against twenty one other applications Applicant had wrongfully applied for in its name. Those proceedings are currently suspended pending the disposition of a civil action between the parties, Case No. CV-02-08508 FMC, pending before the U.S. District Court for the Central District of California.

9. Registration of Applicant's Mark will give color of exclusive statutory rights in the Marks to Applicant in derogation and violation of the rights of Opposer.

**COUNT ONE: FRAUD IN THE APPLICATIONS**

10. Opposer realleges and incorporates herein by reference the allegations in all other paragraphs contained in herein.

11. On May 24, 2007 Applicant submitted an application with sworn declaration to the Trademark Office stating that Applicant:

declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

12. As stated above, Applicant was not the owner of the Mark at the time that Applicant filed the application. At that time and currently, Applicant was and has been, at most, only a licensee of Opposer. As such, Applicant does not have ownership rights in the Mark.

13. Upon information and belief, Applicant knew or should have known that it made false statements to the U.S. Patent and Trademark Office when Applicant alleged that it is the owner of the Mark.

14. On information and belief, Applicant made the above declaration with the knowledge that the statement were false and in violation of 15 U.S.C. § 1051(b).

15. On information and belief, the false declaration was made with the intent to induce authorized agents of the Trademark Office to approve Applicant's application and grant Applicant's registration, and reasonably relying on the truth of the statement, the Trademark Office, did in fact, approve the application for publication.

**COUNT TWO: LACK OF OWNERSHIP**

16. Opposer realleges and incorporates herein by reference the allegations in all other paragraphs contained herein.

17. Opposer is the rightful owner of the Marks; Applicant was not at any relevant time the owner of the Mark or entitled to register the Mark in the U.S.

18. The application for the Mark are void pursuant to Section 1 of the Trademark Act and Trademark Rule § 2.71(d) as the application was filed and prosecuted by an entity other than the owner or an entity without the exclusive right to register the Mark.

**COUNT THREE: LIKELIHOOD OF CONFUSION**

19. Opposer realleges and incorporates herein by reference the allegations in all other paragraphs contained herein.



20. There is no issue of priority in this proceeding. Opposer's trademark rights in the Marks precede the filing date of Applicant's application for the Mark. Therefore, Opposer has prior and superior rights in this matter.

21. Because Applicant is merely a licensee of Opposer, and Applicant has applied for registration of the Mark in its own name, and because Applicant's Mark so closely resemble Opposer's prior filed trademark registrations for WINNIE-THE-POOH CHRISTOPHER ROBIN and Opposer's rights in other marks related to the characters of The Winnie-the-Pooh Stories, that registration of Applicant's Mark is likely to cause confusion, mistake, and deceive purchasers into erroneously believing that Applicant, and not Opposer, is the rightful owner of the Mark, in violation of 15 U.S.C. § 1052(d).

**COUNT FOUR: DILUTION**

22. Opposer realleges and incorporates herein by reference the allegations in all other paragraphs contained herein.

23. The Marks were famous as defined under Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c), prior to Applicant's filing date.

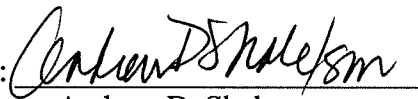
24. The Marks were inherently distinctive prior to Applicant's filing date.

25. Opposer engaged in substantially exclusive use and/or control of the Marks prior to Applicant's filing of its application.

26. Applicant's intent to register the Mark will impair the distinctiveness of Opposer's rights in the Marks to identify and distinguish the goods and services of Opposer. Registration of Applicant's Mark will further damage Opposer in violation of Section 43(c) of the Trademark Act, 15 U.S.C. § 1125(c).

WHEREFORE, Opposer believes that it will be damaged by the registration of Applicant's Marks and requests that judgment be entered in its favor and against Applicant on all counts and that Application Serial No. 77/189502 for the mark CLASSIC POOH be denied registration.

Respectfully submitted,  
STEPHEN SLESINGER, INC.

By: 

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Attorneys for Opposer  
Stephen Slesinger, Inc.

Dated: July 27, 2009

**SCHEDULE A***Stephen Slesinger, Inc. v. Disney Enterprises, Inc.*

Opposition No. \_\_\_\_\_

Applicant's Mark and Applied for Goods

<u>Serial No.</u>	<u>Mark</u>	<u>Goods</u>
77/189502  Filed:  May 24, 2007	CLASSIC POOH (& Design)	IC 16: Address books; almanacs; appliques in the form of decals; appointment books; art prints; arts and craft paint kits; autograph books; baby books; ball point pens; baseball cards; binders; bookends; bookmarks; books featuring games; books featuring stories for children; series of fiction books; bumper stickers; calendars; cartoon strips; Christmas cards; chalk; children's activity books; coasters made of paper; coin albums; coloring books; color pencils; comic books; comic strips; coupon books; decals; decorative paper centerpieces; diaries; disposable diapers for babies; drawing rulers; envelopes; erasers; felt pens; flash cards; gift cards; gift wrapping paper; globes; greeting cards; guest books; magazines featuring stories, games and activities for children; maps; memo pads; modeling clay; newsletters featuring stories, games and activities for children; newspapers; note paper; notebooks; notebook paper; paintings; paper flags; paper party favors; paper cake decorations; paper party decorations; paper napkins; paper party bags; paper weights; paper gift wrap bows; paper pennants; paper place mats; paper table cloths; pen or pencil holders; pencils; pencil sharpeners; pen and pencil cases and boxes; pens; periodicals featuring stories, games and activities for children; photograph albums; photographs; photo-engravings; pictorial prints; picture books; portraits; postcards; posters; printed awards; printed certificates; printed invitations; printed menus; recipe books; rubber stamps; score cards; stamp albums; stationery; staplers; stickers; trading cards; ungraduated rulers; writing paper; writing implements

**SCHEDULE B***Stephen Slesinger, Inc. v. Disney Enterprises, Inc.*

Opposition No. \_\_\_\_\_

Opposer's Goods and Registrations

<b>Reg. No.</b>	<b>Mark</b>	<b>Goods</b>
283,856	WINNIE-THE- POOH CHRISTOPHER ROBIN	Wearing apparel for men, women, and children — namely, nightgowns, nightshirts, and pajamas, underwear made of knitted, netted and textile materials, shoes and slippers made of leather, fabric, rubber and/or combinations thereof; women's and children's coats, cloaks, and suits; and men's and boys' suits, including coats, vests, and trousers and overcoats; sweaters, hats, caps for men, women and children, and bathing suits.
302,372	WINNIE-THE- POOH CHRISTOPHER ROBIN	Chinaware and pottery, bric-a-brac, and reflectors, globes and shades of china and porcelain.
302,240	WINNIE-THE- POOH CHRISTOPHER ROBIN	Games – namely, card games, board games, educational card games, puzzles, parlor board games; toys – namely figure toys, dolls, doll houses, mechanical toys, construction toys and roller toys; and sporting goods – namely baseball bats, gloves, masks, leg guards, balls; tennis rackets, nets, balls; footballs, football masks, leg guards, shin guards; basketballs and nets; lacrosse clubs, balls, body guards, masks; golf balls, clubs, golf bags; skates, both roller and ice.
304,587	WINNIE-THE- POOH CHRISTOPHER ROBIN	Candle sticks, lamp shades not made of glass, but of such materials as silk, linen, paper, wood and metal; and lamp bases.
313,255	WINNIE-THE- POOH CHRISTOPHER ROBIN	Flat and hollow silverware used for table and toilet purposes.

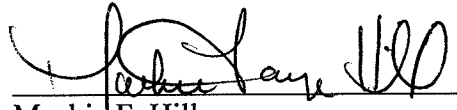
**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing **NOTICE OF OPPOSITION** was served by U.S. mail, first class, postage prepaid, on this 27<sup>th</sup> day of July, 2009 on the Applicant at the address listed in the current U.S. Trademark Office Records as follows:

Steven Plotkin  
The Walt Disney Company  
500 S Buena Vista St. Corporate Legal-Trademark Department  
Burbank, CA 91251-0007

and a courtesy copy to:

Daniel M. Petrocelli  
O'Melveny & Myers LLP  
1999 Avenue of the Stars, Suite 700  
Los Angeles, CA 90067

  
Mackie F. Hill